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IN THE

Supreme Court of the United States

OCTOBER TERM, 1940
No. 347

FOOD MACHINERY CORPORATION,
Petitioner,

vs.

FRUIT TREATING CORPORATION, WINTER PARK PACKING COMPANY, McDONALD CORPORATION, UMATILLA FRUIT COMPANY, and L. E. HOLLOWAY, TRADING as L. E. HOLLOWAY & COMPANY,
Respondents.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is an ordinary patent case in which the defendants, respondents here, relied upon the usual defenses of invalidity and non-infringement. The Circuit Court of Appeals decided both of these issues in favor of respondents.

There is no conflict of decisions between courts in different circuits, nor does the petition set forth any novel questions to be decided, for indeed, there are none.

The Harvey patent in suit, granted May 16, 1933, No. 1,909,860, relates to the dyeing of citrus fruit including oranges. Briefly, the process of dyeing oranges consists in immersing the oranges in a bath containing the dye at

a temperature and for a period sufficient to obtain the desired color just as a garment or other cloth might be dyed.

The case was heard in the first instance before the District Court for the Southern District of Florida, Judge Alexander Akerman, who decided the case at the close of the trial without receiving written briefs. No written opinion was handed down by the District Court.

Upon the whole record, which was before it, the Court of Appeals passed upon the questions of validity and of infringement and stated (112 F. (2d), 119; R. 685):

> "The record contains abundant evidence relating to the questions of whether the invention was anticipated in the prior art and hence not subject to patent, and whether the coloring process used by appellants infringed the patent. The prior-art attack appears meritorious, and we are also of the opinion that there was no infringement; but we prefer to rest our decision upon other grounds which render further discussion of these questions unnecessary."

It is clear, therefore, that the Court below held the prior art relied upon by respondents was sufficient to invalidate the claims of the patent before it and that respondents' way of dyeing oranges did not infringe the patent, either of which holdings must result in dismissal of the bill of complaint.

But confronted with a patent[1] so broad and comprehensive in description and with claims so nebulous, ambiguous, and "all-inclusive" as to be capable of being read to encompass any and all methods of dyeing any and all citrus fruit in a liquid dye bath, the Court, *sua sponte*, pointed out a further reason for dismissing the bill of complaint, in addition to the two above mentioned.

It is solely to this latter branch of the case that the petition for writ of certiorari is directed since the holdings of the Court of Appeals with respect to the prior art and non-infringement are disregarded.

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[1] The Harvey patent in suit is reproduced page 423 of the record.

Petitioner advances two reasons for the grant of the petition which may be summarily stated and answered as follows:

Reason 1.

Although ambiguous in statement this point in substance is based upon the proposition that the practice of dyeing citrus fruit is concentrated in the Fifth Circuit and that this Court should therefore review the case.

The "industry in which the patented method is used" is the citrus industry but the largest producer of citrus fruit is the State of California in the Ninth Circuit.

Although the dyeing of citrus fruit is carried on extensively in Florida and to a lesser extent in Texas, it does not follow that dyeing of citrus fruit is practiced in no other areas. As a matter of fact, the petitioner itself has carried on the practice in California at least experimentally (R. 176) and others have dyed fruit there (R. 300, 325, 333). Moreover, any process directed to enhancing the external appearance of citrus fruit is likely to be used wherever the fruit is grown.

While the concentration of an industry, such as the manufacture of automobiles which are in wide and almost universal use, may be one reason for granting certiorari (*Schriber-Schroth Co.* v. *Cleveland Trust Co. et al.*, 305 U. S. 47, 50), this Court has not indicated that such a fact is of general or compelling significance.

Reason 2.

This point as expressed in the petition is that the Court of Appeals has decided the case upon the grounds of insufficiency of disclosure of the patent specification which petitioner contends is a matter for affirmative defense raising an issue of fact.

There is, we submit, no substance in this point.

(1) The Court of Appeals, on the entire record, as pointed out above, held that the prior art attack upon the validity of the patent was meritorius and further that there

was no infringement. Either of these holdings must result in a direction to dismiss the bill of complaint.

(2) The Court of Appeals has said in effect that this patent, as a matter of law, when considered on its face is so comprehensive and general in description and so nebulous, ambiguous and "all-inclusive" with respect to its claims that the patentee has not met the burden placed upon him by the patent statutes.

The Court of Appeals has set forth in its opinion ample authority to sustain what it has held. It has seen fit to point out an additional reason warranting dismissal of the bill of complaint.

It is a settled rule of this Court that if the patent is invalid on its face the Court may stop short at the instrument and dismiss the bill (*Brown* v. *Piper*, 91 U. S. 37, 44) even when the question of validity is not raised by the pleadings (*Slawson* v. *Grand Street R. R. Co.*, 107 U. S. 649).

In *Brown* v. *Piper, supra,* this Court considered the patent before it in the light of the record and held it to be anticipated by prior art in evidence. The Court thereupon proceeded in its opinion by saying (p. 41, near bottom): "There is another view of the case that may properly be taken." And then the Court discussed the patented method in view of the well known ice cream freezer which had not been considered by the lower court. That case has long since become classic not only in patent law but in the general law as well. The opinion of this Court concludes:

> "Examined by the light of these considerations, we think this patent was void on its face, and that the court might have stopped short at that instrument, and without looking beyond it into the answers and testimony, *sua sponte*, if the objection were not taken by counsel, well have adjudged in favor of the defendant."

In the instant case the Circuit Court of Appeals followed the procedure thus succinctly approved by this Court. In

addition to the reasons previously given with respect to the prior art and non-infringement based upon the record, the Court, upon consideration of the patent itself, *sua sponte*, found it did not comply with the requirements of the patent statutes.

Finally, we call this Court's attention to *Permutit Co.* v. *Graver Corporation*, 284 U. S. 52, cited by the Court below in its opinion, and particularly to page 60 where this Court said:

> "The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, *but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.*" (Italics ours.)

See also, *General Electric Co.* v. *Wabash Appliance Corp. et al.*, 304 U. S. 364, 369.

The Harvey patent in issue has not met the test laid down by this Court, as the Circuit Court of Appeals has said and as a perusal of it will show.

We submit that no grounds have been presented which justify a review of the case by this Court. The petition for writ of certiorari should be denied.

Respectfully submitted,

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